

CLAIM STATUS AND SUPPORT FOR CLAIM CHANGES

After this Amendment, claims 1-10 and 15 remain canceled, while previously presented claims 12 and 13 have now been canceled without prejudice. Previously presented claims 11-14 and 16-27 remain pending and unchanged.

REMARKS

A Supplemental Declaration is submitted herewith in view of the cancellation of claims 12 and 13 without prejudice. The cancellation of these two claims also renders moot, the objections and rejections set forth in numbered sections 1-7 of the Office Action.

With reference now to the prior art rejections set forth in the Office Action, claims 11, 14, 16-21 and 23-26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Andrews et al. (Pat. No. 6,186,977). The remaining pending claims, 22 and 27, stand rejected under 35 USC 103 as being unpatentable over Andrews et al. in view of Dudley (Pat. No. 3,905,363) or Sundblom et al. (Pat. No. 3,820,566). As will be clearly established below, these rejections are traversed because Andrews et al. fail to establish a prima facie case of obviousness under 35 U.S.C. 103.

Examiner's Arguments in Support of Rejection of Claims 11 et al.

In support of the rejections over Andrew's et al., the Examiner asserts that regarding claim 11, Andrews et al. disclose a multi-component emergency medical system 10 comprising: a breathable oxygen delivery system 50; a defibrillation system 65; at least one measurement system 40 which measures at least one of blood or gas content saturation, affinity or, perfusion: (see sensors 42 and 43); and a unitary casing 22 for housing said oxygen delivery system, said defibrillation system and said measurement system.

Regarding the limitations pertaining to the cumulative size and weight of the unitary casing, oxygen delivery system, defibrillation system, and measurement system, the Examiner cites the following case law noted in MPEP Section 2144.04:

1) The courts have long recognized that changes in size or proportion are not sufficient to saliently distinguish over prior art inventions merely differing in scale (see *In re Rose*, 220 F. 2d 459, 105 USPQ 237 (CCPA 1955)).

2) The courts have also indicated that the mere act of making a device portable is not sufficient by itself to warrant patentability (see *In re Lindberg*, 194 F.2d 732, 93 USPQ 23 (CCPA 1952)).

3) *Ex parte Wu*, 10 USPQ 2031 (Bd. Pat. App. & Interf. 1989), *in re Larson*, 340 F. 2d 965, 144 USPQ 347 (CCPA 1965) and *In re Kuhle* 526 F. 2d 553, 188 USPQ 7 (CCPA 1975) all relate to decisions where the elimination of a step or element and its function have been considered obvious if the function of the element is not desired.

The Examiner also notes that Andrews et al. further teach that the casing 22 should be relatively compact in order to enhance mobility of the system and it is disclosed throughout the specification that many different modifications and embodiments of the invention are possible depending on the application and preferences of the designer.

Finally, the Examiner concludes that given the general desire and recognized need in emergency medical situations to provide lightweight, portable equipment, and given the various court cases and teachings of Andrews et al. elaborated above, those of ordinary skill in the emergency medical treatment art would have considered it obvious to make the system of a size and weight to allow single hand/hand-held portability. It is the type of emergency and patient most likely to be encountered that would dictate the equipment necessary to be contained within the casing and thus the relative size and weight of the overall system.

The Examiner further contends that all of the systems recited by the applicants are old and well-known in the prior art. With a reasonable expectation of success, one skilled in the art could have combined the elements as claimed with no change in their respective functions, and the combination would have yielded nothing more than predictable results. The Examiner concludes that for all of the above reasons, one of ordinary skill in the art would have at least

found it obvious to try making the system of a size and weight which can easily be carried by a single hand or hand-held.

Applicants' Arguments Traversing Rejection

First and foremost, Applicants respectfully traverse the rejection of the claims over Andrews et al. because this single reference by no means establishes a prima facie case of obviousness under 35 U.S.C. 103 as to claim 11 or any of the rejected claims that are dependent on claim 11. Only through the impermissible use of hindsight through reference to Applicants own disclosure would one of ordinary skill in the art, having only the Andrews patent before them, think to make the major modifications to the Andrews anesthesia delivery apparatus which would be necessary to arrive at the invention of claim 11.

Regarding hindsight, MPEP Section 2142 on establishing a prima facie case of obviousness under 35 U.S.C. 103 specifically states:

To reach a proper determination under 35 U.S.C. 103, **the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made.** In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious **at that time** to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art. (emphasis added)

The bolded portions of the above passage are particularly relevant in the present case because **the original application**, on which the subject continuation reissue application is based, **was filed 10 years ago in 1998**. In the Office Action, the Examiner makes repeated assertions in

the *present tense* as to what would be obvious now, 10 years after the subject application was first filed. This may have been an oversight, but the fact of the matter is, when the invention was first made over 10 years ago, it was simply unheard of to place a source of medical oxygen for patient treatment, a defibrillator and a device for measuring a parameter of the patient in a single unitary casing that can be readily carried by a single hand. While portable defibrillators existed back then, these devices were much larger and were always contained in their own dedicated housing and did not include oxygen delivery systems and patient monitoring devices. All of the assertions in present tense on pages 5-7 of the Office Action ignore the relevant time period of the invention of 1998. Applicants respectfully note that the state of the art in 1998 was 10 years less developed and advanced than the present.

The present invention is a unit of a size and weight that can be easily carried with one hand and includes both a source of medical oxygen for patient treatment, a defibrillator and a device for measuring a parameter of the patient. The purpose of the invention is to provide a convenient easily transported unit for paramedics and others in the field which provides the multiple functions of a source of medical oxygen, a defibrillator and a device for patient diagnosis and/or monitoring. The unit can be easily carried with a single hand by emergency personnel to the victim or patient at an accident scene, for example, and avoids the need to collect and carry multiple separate pieces of equipment which is inconvenient and would likely necessitate use of both hands.

The examiner has cited Andrews et al. in an attempt to establish a prima facie case of obviousness under 35 U.S.C. 103 as to claim 11. Applicant respectfully submits that Andrews et al. do not establish obviousness of the invention recited in claim 11 because there is no motivation to modify the device in Andrews et al. in the manner suggested by the examiner,

absent the impermissible use of hindsight through reference to Applicant's own disclosure. More particularly, the examiner suggests that it would be obvious to place selected components of the Andrews apparatus in a unitary housing that is easily carried by a single hand. Applicants respectfully disagree and note that the selective picking of some but not all of the components in Andrews would completely defeat the whole purpose of Andrews et al., which is to administer anesthesia to a patient. Emergency field technicians are not surgeons and do not arrive at accident scenes, for example, with equipment to anesthetize a patient for surgery.

The assertion that it is obvious to leave steps or elements out of a known device relies on a case that is not applicable to the present situation where leaving out the anesthesia and other components of Andrews et al. would defeat the whole purpose of the Andrews et al. system. MPEP Section 2143.01(V) states that the proposed modification cannot render the prior art unsatisfactory for its intended purpose:

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

The subject invention is not concerned with this issue because Applicant's device is for the completely different purposes of supplying supplemental medical oxygen to a patient at the scene of an accident, for example, and or restarting a person's heart rhythm if necessary with the defibrillator; and at the same time, monitoring the condition of the patient to determine the need for the supplemental oxygen or the defibrillator. Emergency personnel aiding victims at the scene of an accident, are expected to hand carry various pieces of equipment to the patient at the scene. It would be desirable to be able to combine multiple pieces of the equipment in a unitary case that can be easily carried by a single hand. This is exactly what the subject invention recited

in claim 11 is designed to provide. There is absolutely no suggestion or disclosure in Andrews et al of forming such a system.

Further, contrary to the Examiner's assertions, Andrews et al. does not disclose a unitary casing 22 for housing said oxygen delivery system inside the same casing that houses the other components named and described as being portable. In fact the drawings in Andrews et al. clearly show the oxygen cylinder, valve, regulator and hose outside the casing that houses the other components. They are mounted externally and are hanging on the side of a casing so large in size and weight that it discloses four weight carrying caster wheels and a substantial handlebar for pushing and steering the Andrews et al. device to where it is needed, excepting of course, if it is needed up numerous flights of stairs to the victim, or down the steep embankment of a highway site of an automobile accident, or in and out of an emergency vehicle transporting medical personnel to the scene of an accident, or with the victim back into the ambulance for transport to the hospital, all situations in which Andrews et al. would be useless.

Regarding the court cases relied upon by the Examiner, the following comments are made for the record.

In re Rose – “Claims directed to a lumber package ‘of appreciable size and weight requiring handling by a lift truck’ were held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentably distinguish over the prior art.”

Applicants do not dispute that it would not be patentable to simply reduce the size of every component in the Andrews device say 50%, for example, unless the size reduction provides some clear unexpected advantage. This is not even remotely the case here. The Examiner picked and chose elements in Andrews et al., some of which were never contained in

the disclosed housing to begin with, and placed these selected elements inside a unitary casing that can be easily carried by a single hand using Applicants' own disclosure as an instruction guide, which is classic impermissible hindsight.

In re Lindberg – “The courts have also indicated that the mere (emphasis added) act of making a device portable is not sufficient by itself (emphasis also added) to warrant patentability. This is irrelevant case law because both Andrews et al. and the invention recited in claim 11 are “portable” already. Andrews et al. uses wheels or casters to aid in portability, which is a clear indication in and of itself that Andrews et al. never intended trying to house all of their equipment in a single unitary casing of a size and weight that could be readily carried by a single hand.

Ex parte Wu, In re Larson, and In re Kuhle The Examiner states that “the elimination of a step or element and its function have been considered obvious if the function of the element is not desired”.

Any suggestion that Andrews et al. would want to delete the key components of their system, including the anesthesia delivery components, completely ignores what the Andrews et al. patent is all about. The foregoing cases clearly do not apply and in fact are overridden by the more relevant case of *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) mentioned above which holds “If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.”

The bottom line is that the claim 11 invention, while disclosing some of the same components of Andrews et al., is specifically of a size and weight that it can be easily carried by a single hand up and down stairs and roadside hills, around tight corners, in and out of

emergency vehicles, all the time leaving the other hand of the first responder free and available to carry other equipment, grab handrails, open doors, provide self defense, and the claimed invention may be transported with the victim to the hospital. In contrast, one might find the Andrews et al. device in the hospital limited to flat floors and elevators requiring both hands and all the body effort of the responder to push the cart to the victim, only within the hospital flat floor limits, and with the oxygen cylinder, valve, regulator, and hose hanging out the side where it will catch on clothing, doorways, railings, bedposts, furniture, etc and impede portability.

The Examiner also comments that Andrews et al. further teach that the casing 22 should be relatively compact in order to enhance mobility of the system and disclose throughout the specification that many different modifications and embodiments of the invention are possible. Every one of the mentions of column 6 lines 59-67 is a relatively stationary location within a hospital or other facility and not even near the size and weight that is easily carried by a single hand, and not providing all the other previously listed distinct functional invention advantages of the claimed subject invention.

In view of the forgoing, Applicants respectfully submit that the rejections of claim 11 and all of the remaining dependent claims 14 and 16-27 are traversed. In addition, as to the rejection of claim 18, which recites the prompting system, Applicants take issue with the Examiner's assertion that the prompting system of claim 18 capable of directing a user through a protocol employing the oxygen delivery system and a measurement system is anticipated by the cellular phone in Andrews et al. This assertion is not merited because there is simply no suggestion anywhere in Andrews that the phone should be used as a prompting system. Further, claim 18 specifies that the prompting system is disposed **within the casing** which is carriable by a single hand. In contrast, the Examiner's reasoning relies upon "...prompts, instructions, or assistance

from a remote center staffed by personnel with medical training...” all of which certainly can not be housed within the same casing of a size and weight carryable by a single hand. For these reasons also, Applicants respectfully submit that the rejections of claims 18 and 19 are further traversed.

In view of the foregoing, Applicants respectfully submit that all the objections and rejections set forth in the Office Action have been overcome or traversed and that the application is now in condition for allowance. Accordingly, favorable reconsideration of the application is respectfully requested.

Respectfully submitted,

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